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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 10/802,086 | 03/16/2004 | Garrett Blythe | MTV-010 | 4038 |
| 42532 | 7590 | 08/24/2010 | EXAMINER | |
| PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110 | | | D'AGOSTINO, PAUL ANTHONY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3714 | |
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| | | | 08/24/2010 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,086

Applicant(s)

BLYTHE ET AL.

Examiner

Paul A. D'Agostino

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/30/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-12,14-18,20-24 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,6-12,14-17 and 27 is/are allowed.
- 6) ☒ Claim(s) 18,20-24, and 28-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 03/30/2010. Claims 6-8 and 14 have been amended. Claims 4-5, 13, 19 and 25-26 stand cancelled. Claims 1-3, 6-12, 14-18, 20-24, and 27-29 are now pending in this application.

Response to Amendment

1. Applicant has cured the problem with the claim numbering. Thus, the objection to the claim number is withdrawn.
2. Applicant has amended to satisfactorily overcome the rejection under 35 U.S.C. § 112, second paragraph. Thus, the rejection of Claims 6-8 and Claims 14-17 is withdrawn.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 18, 20-24, and 28-29 are rejected under 35 U.S.C. 101 because the computer-executable instructions are not claimed as embodied in a non-transitory computer-readable storage medium. Applicant's claim is not limited solely to tangible embodiments. The claimed subject matter, given the broadest reasonable interpretation, may be a carrier wave comprising of instructions and is, therefore, non-statutory. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during

proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer-readable storage medium typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable storage media, particularly when the specification is silent. (See MPEP 2111.01). When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2. To overcome this type of 101 rejection, the claims need to be amended to include only the physical computer storage media (e.g. non-transitory computer-readable storage medium) and to be unassociated with any transmission media or other intangible or non-functional media. Examiner suggests adding the words "non-transitory" to the "computer-readable storage medium" in the claims. Other word choices will be considered but the ones proposed shall overcome the rejection. Appropriate attention is required.

Allowable Subject Matter

5. Claims 1-3, 6-12, 14-17, and 27 are allowed.
6. The following is an examiner's statement of reasons for allowance: the prior art of

record neither anticipates nor renders obvious Applicant's claimed invention wherein, in combination with the other claimed limitations, the client program automatically detects when selected individuals are playing one or more multiplayer games on the computer network, notifies a user of the games and selected individuals playing the games, searches for and detects when one or more of the games are executing on the terminal, and communicates data identifying the running games and the user over the computer network for receipt by selected individuals; wherein the second program, which is separate from the games executing on the terminal, determines a connection status of the executing games and communicates the connection status to the client program; and wherein the client program communicates the connection status of the executing games over the computer network for receipt by the selected individuals.

7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. D'Agostino/
Examiner, Art Unit 3714